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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,054	01/26/2001	Richard A. Mallo	56147USA8A.002	7236
7590 08/23/2004			EXAMINER	
Attention: Yen Tong Florczak Office of Intellectual Property Counsel			FUBARA, BLESSING M	
3M Innovative Properties Company			ART UNIT	PAPER NUMBER
P.O. Box 33427			1615	
St. Paul, MN 55133-3427			DATE MAILED: 08/23/2004	1

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.	Applicant(s)			
09/771,054	MALLO ET AL.			
Examiner	Art Unit			
Blessing M. Fubara	1615			
ears on the cover sheet with th	e correspondence address			
IS SET TO EXPIRE 3 MONT (36(a). In no event, however, may a reply be within the statutory minimum of thirty (30) will apply and will expire SIX (6) MONTHS from the come ABANDO date of this communication, even if timely	e timely filed  days will be considered timely.  rom the mailing date of this communication.  DNED (35 U.S.C. § 133).			
•				
<u>5/04</u> .				
This action is <b>FINAL</b> . 2b) ☐ This action is non-final.				
nce except for formal matters, Ex parte Quayle, 1935 C.D. 11,	prosecution as to the merits is , 453 O.G. 213.			
application.  are withdrawn from consideration  r election requirement.	on.			
er. epted or b) objected to by the drawing(s) be held in abeyance. tion is required if the drawing(s) is the attached Offer.	See 37 CFR 1.85(a). objected to. See 37 CFR 1.121(d).			
priority under 35 U.S.C. § 119 s have been received. s have been received in Applic rity documents have been rece u (PCT Rule 17.2(a)).	cation No eived in this National Stage			
	siveu.			
4) Interview Summ Paper No(s)/Ma 5) Notice of Inform 6) Other:				
	Examiner  Blessing M. Fubara  ears on the cover sheet with the SET TO EXPIRE 3 MONT (18) (18) In no event, however, may a reply be switch the statutory minimum of thirty (30) within the statutory minimum of thirty with the statutory minimum of thirty (30) with a statutory minimum of thirty (30) with the statutory minimum of			

Patent and Trademark Office OL-326 (Rev. 1-04)

Application/Control Number: 09/771,054

Art Unit: 1615

## **DETAILED ACTION**

Examiner acknowledges receipt of amendment and remarks filed 06/01/04. Claims 15-28 are cancelled in favor of new method claims 28-41, 13 and 14. The composition claims that were originally elected are now cancelled. New method claims that were not elected by the originally presented claims are now presented.

Examiner will consider the method claims if presented in the proper vehicle.

1. Newly submitted claims 29-41 and amended claims 13 and 14 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The method claims now presented are distinct and independent of the previously examined claims as confirmed by applicants in the remarks, "the claims as amended recite a method of using the previous claimed composition in human cosmetic uses as a film forming compound. The use not taught or suggested in the art of record." Thus, different patents within the art can support the method of use of the composition now presented and the composition that was originally presented and applicants in the remarks support this. The originally presented claims are classified in 524/588 and the new method claims are classified in 424/401.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 13, 14 and 29-41 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Applicants' arguments filed 06/01/04 have been fully considered but they are not persuasive.

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Applicants argue that method claims are not taught in the art of record. Examiner finds that the composition as originally claimed is found in the art of record and if the composition claims have not been cancelled, the rejection on record would be maintained. Examiner will be happy to consider the method claims if presented in the proper vehicle.

## Observation:

Claim 41 is presented as new claim that contains amendment. This does not appear to comply with the amendment practice of the office.

3. Applicants' amendment necessitates maintaining that the originally presented claims are found in the art of record and the new method claims are withdrawn from consideration as being directed to a non-elected invention. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

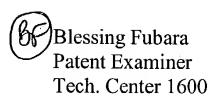
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600